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IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): John M. BARON et al.

Confirmation No.: 9746

Application No.: 09/935,249

Examiner: D.Y. Chow

Filing Date: Aug. 22, 2001

Group Art Unit: 2675

Title: ACCELERATION-RESPONSIVE NAVIGATION AMONG MODE VARIABLES

Mail Stop Appeal Brief-Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Sir:

Transmitted herewith in ~~triplicate~~ is the Reply Brief with respect to the Examiner's Answer mailed on March 23, 2005. This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new grounds of rejection.)

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Respectfully submitted,

John M. BARON et al.

By

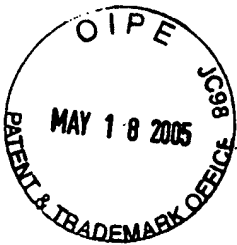
Brian S. Rosenbloom

Attorney/Agent for Applicant(s)

Reg. No. 41,276

Date: May 18, 2005

Telephone No.: (202) 783-6040



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Applicant : John M. Baron
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Examiner : Chow, Doon Y.

Docket No. : 10010911 (2873-017)
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APPELLANT'S REPLY BRIEF UNDER 37 C.F.R. § 41.41

Sir:

The following comprises a reply to the Examiner's Answer
("Answer") mailed March 23, 2005.

Grouping Of Claims

The Examiner asserts that the rejection of claims 1-20 stand or fall together "because appellant's brief does not include a statement that this grouping of claims does not stand or fall together"¹ The Examiner's assertion has no merit.

The rules regarding appeals to the Board no longer require the appellant to include a statement regarding grouping of claims. The applicable rule is now rule 41.37. Appellant has fully complied with rule 41.37. For example, for every claim argued separately, appellant has placed the claim under a subheading identifying the claim by number. Accordingly, claims 1-20 do not stand and fall together.

REPLY TO PRIOR ART REJECTIONS

A. Independent Claim 1

With respect to the rejection of claim 1, the Examiner continues to contend that Thomas "inherently comprises an icon graphical user interface (a plurality of icons) because it is known that a conventional digital appliance such as the Palm Pilot comprises an icon graphical user interface (plurality of icons)."² As discussed in appellant's brief, in order to establish inherency the Examiner "must provide a basis in fact

¹ Answer, p. 2.

² Answer, p. 6

and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art."³ The Examiner has provided no basis in fact or technical reasoning to support the allegation that the digital appliance disclosed in Thomas necessarily displays a plurality of icons. The Examiner reasoning seems to be that because conventional digital appliances display icons, it necessarily follows that all digital appliances display icons. This logic is faulty. It does not necessarily follow that all digital appliances display icons merely because some display icons. Accordingly, the digital appliances disclosed in Thomas do not necessarily display icons. For example, the digital appliance could be an electric book that only displays text (i.e., it does not display any icons). Accordingly, the Office has not established its theory of inherency. For at least this reason, the rejection of claim 1 should be withdrawn.

Furthermore, even if we assume for the sake of argument that the digital appliance disclosed in Thomas inherently displays icons, Thomas does not teach or suggest a graphical selection indicator that is used to "select from among a plurality of displayed icons." As discussed in the appeal brief, the only factual basis the Office has put forth to support its proposition that Thomas suggests the feature in question is that Thomas teaches using an accelerometer instead of a mouse to move the cursor 506. However, substituting an accelerometer for a mouse is irrelevant to the question of

³ M.P.E.P. § 2112 (emphasis added)

whether Thomas suggests that cursor 506 is "moved to select from among a plurality of displayed icons," as is recited in claim 1. Moreover, the Office does not explain why substituting an accelerometer for a mouse has any bearing on whether Thomas suggests that cursor 506 is "moved to select from among a plurality of displayed icons." Thus, for this additional reason, the rejection of claim 1 should be withdrawn.

B. Independent Claim 13

The Examiner contends that appellant's construction of the claim term "mode variable" is irrelevant.⁴ The Examiner is wrong. It is axiomatic that the first step in determining the validity of a claim is to construe the claim. Without construing the meaning of the terms of the claim, how can one know what the claim covers? Accordingly, the Examiner's contention that appellant's claim construction is irrelevant is wrong.

The Examiner also states, "Thomas inherently teaches, as evident from above, displaying a plurality of icons which represent a plurality of applications (a plurality of mode variables)."⁵ Thus, the Examiner is equating an "icon that represents an application" with a "mode variable." The Examiner is wrong to equate the two. A mode variable is not an icon that

⁴ Answer, p. 7 ("Appellant further argues that a mode variable is a 'setting that the user can change during operation of the image capturing device.' This argument is irrelevant because claim 13 does not require the limitation as argued.").

represents an application⁶.

As stated in the appeal brief, the proper construction of the term "mode variable" is "[a] setting[] that the user can change during operation of the image capturing device 100, such as flash settings, focus settings, image resolution, etc."⁷ Thus, a "mode variable" is clearly different than an "application." Furthermore, the Examiner has not provided any reasoning for equating a "mode variable" with an application, nor has the examiner provided any support for his definition that "mode variable" reads on an icon representing an application. Therefore, appellants respectfully request that the rejection of claim 13 be withdrawn.

C. Dependent Claim 2

The Examiner contends that the "acceleration sensing means [disclosed in Thomas] inherently comprises three sensors because each movement about each axis requires a sensor."⁸ However, the Examiner's premise that "each movement about each axis requires a sensor" is unsupported by any basis in fact or technical reasoning. As discussed above, "in relying upon the theory of inherency, the Office Action must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the

⁵ Answer, p. 7.

⁶ To one of ordinary skill in the art, an "application" is "a complete, self-contained program that performs a specific function." The Free On-Line Dictionary of Computing, <http://foldoc.doc.ic.ac.uk/foldoc/index.html>

⁷ Para 0017 of the present application.

⁸ Answer, p. 7

teachings of the applied prior art."

In this case, the Examiner has put forth no evidence or even a technical reasoning to support the assertion that three sensors are necessarily required in order to sense an acceleration motion in three orthogonal directions. Accordingly, the Examiner has not met his burden and the rejection of claim 2 should be withdrawn.

Moreover, not only has the Examiner not met his burden, but it is not true that three separate sensors are required to sense acceleration in three different directions. Specifically, the disclosure of the present invention states, "[t]he at least one sensor 108 may be a 3-axis accelerometer ... from Fuji Electirc Co., Japan." Accordingly, a sensor does exist that can sense acceleration along 3 axis. Thus, the Examiner's inherency argument is not supported by the facts.

D. Independent Claim 9

Claim 9 requires "a memory ... storing a predetermined threshold ... wherein [a] processor moves said graphical selection indicator ... if said acceleration signal exceeds said predetermined threshold." ⁹ Thus, according to claim 9, the processor moves the graphical indicator only "if said acceleration signal exceeds said predetermined threshold." The Examiner contends that Feinstein discloses this feature. The Examiner is wrong. Feinstein does not disclose this feature.

⁹ Claim 9 (emphasis added).

Feinstein discloses "a minimum response threshold to allow the navigation to stop when the operator slightly reverses direction of orientation."¹⁰ In other words, to stop the navigation, the user must only slightly reverse the direction of orientation. Accordingly, Feinstein teaches that the navigation stops if the acceleration signal is less than a minimum response threshold (i.e., a slight reverse).

In contrast, claim 9 requires that the indicator is moved if the acceleration signal is greater than (i.e., exceeds) a threshold. Thus, Feinstein discloses the exact opposite of what is being claimed. Feinstein stops movement if the signal is less than a threshold, whereas claim 9 requires initiating movement if the signal is greater than a threshold.

Therefore, the Examiner is wrong to assert that Feinstein discloses "a memory ... storing a predetermined threshold ... wherein [a] processor moves said graphical selection indicator ... if said acceleration signal exceeds said predetermined threshold," as is recited in claim 9.

Conclusion

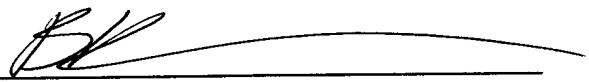
All of the grounds for the rejections of the present claims as advanced by the Examiner are submitted to be unsupportable by the record, and thus improper.

¹⁰ Feinstein, col. 9, lines 15-22.

Appellant's Reply Brief
under 37 C.F.R. § 41.41
Serial Appln. No. 09/935,249

The Honorable Board is therefore respectfully requested to reverse the final rejection, and to direct the passage of this application to issue.

Respectfully submitted,

By 
Brian S. Rosenbloom
Attorney for Appellant
Registration No. 41,276
ROTHWELL, FIGG, ERNST & MANBECK, p.c.
Suite 800, 1425 K Street, N.W.
Washington, D.C. 20005
Telephone: (202) 783-6040
Facsimile: (202) 783-6031

Date: 5/18, 2005